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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,429	10/24/2005	Adrian David Lincoln	P08620US02/BAS	8445
881 7590 11/10/2009 STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			EXAMINER HENNING, MATTHEW T	
			ART UNIT 2431	PAPER NUMBER
			MAIL DATE 11/10/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,429

Applicant(s)

LINCOLN ET AL.

Examiner

MATTHEW T. HENNING

Art Unit

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/5508)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

This action is in response to the communication filed on 7/21/2009.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 7/21/2009 have been fully considered but they are not persuasive.

Regarding the applicants' argument that Ohashi does not teach that neither obtaining certificate nor subsequently obtaining permission information uses authentication information "corresponding to information which is used to authenticate that user's telecommunications terminal in relation to the telecommunications system", the examiner does not find the argument persuasive. It appears that the applicants have misinterpreted the rejection. The predetermined information is the "user certificate" which is stored in the smart card. The certificate is later used to authenticate the user, and thus the user's client terminal, to the service provider. Further, "a telecommunications network" is simply a network for the transmission and reception of information of any type using electrical or optical signals sent over wires or fibers or through the air. As such, Fig. 1 of Ohashi depicts a telecommunications network to which the user's telecommunications terminal is authenticated. Therefore, Ohashi does teach this claim limitation. As such, the examiner does not find the argument persuasive.

Regarding the applicants' argument that Ohashi did not teach that "the authentication process for authenticating the transaction by that user with the data processing apparatus neither requires that user's telecommunications terminal nor requires the telecommunications terminal to be actually authenticated by that information in relation to the telecommunications systems", the examiner does not find the argument persuasive. In rejecting the claims, the examiner has relied

1 upon the client terminal which the client uses to first obtain the certificate as reading on "the
2 user's telecommunications terminal". Ohashi clearly states that there are numerous client
3 terminals having similar constitution to this first client terminal, as can be seen in Col. 11 Lines
4 30-33. Ohashi further teaches that the certificate obtaining step can be ignored when the smart
5 card already stores a valid certificate, as can be seen in Col. 12 Lines 23-30. As such, Ohashi
6 clearly teaches that any client terminal may be used in performing the authentication with the
7 application server. Furthermore, Ohashi does not teach that it is required that the client terminal
8 is always the user's client terminal, or that it is required that the client terminal be actually
9 authenticated by the information in relation to the telecommunications systems. Rather it is the
10 smart card which is authenticated. In this case, because the contested limitation is a negative
11 limitation, the absence of "requirement" in Ohashi meets the negative limitation. As such, the
12 examiner does not find the argument persuasive.

13 Regarding the applicants' argument that Ohashi does not teach "each authentication
14 storage means storing predetermined authentication information and being registerable with a
15 common telecommunications system for which the users have respective telecommunications
16 terminals", the examiner does not find the argument persuasive. As discussed above, Ohashi
17 teaches a plurality of client terminals in the telecommunications system, and that each smart card
18 stores a certificate which is obtained by request from the telecommunications system. Ohashi
19 further teaches storing the user's secret keys associated with the smart card inside a database at
20 the Master AuC, as can be seen in Col. 5 Lines 27-31. This falls within the scope of "being
21 registerable with a common telecommunications system for which the users have respective
22 telecommunications terminals". As such, the examiner does not find the argument persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., registration of a SIM card with a cellular telecommunication network; use of a SIM card) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the applicants request for evidence of the official notice taken in the office action dated January 21, 2009, the examiner provides the following evidence. Regarding the fact that levying a charge for a transaction (providing network services) was well known in the art at the time of invention, the examiner points to US Patent 5,978,387, Col. 1 Lines 15-48.

Regarding the fact that smart cards communicating wirelessly with their readers was well known in the art at the time of invention, the examiner points to US Patent Application Publication 2003/0024994, Paragraph 0028. As such, the examiner does not find the arguments persuasive.

All objections and rejections not set forth below have been withdrawn.

Claims 1-26 have been examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 9, 11-16, 20-24, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohashi et al. (US Patent Number 5,761,309) hereinafter referred to as Ohashi.

Regarding claim 1, Ohashi disclosed a method for carrying out an authentication process for authenticating a subsequent transaction by any one of a plurality of users with data processing apparatus (client) (Ohashi Abstract), including the step during the authentication process of operatively associating with the data processing apparatus a selected one of a plurality of authentication storage means (smart card) respective to the users, each authentication storage means storing predetermined authentication information and being registerable with a common telecommunications system for which the users have respective telecommunications terminals (Ohashi Col. 12 Lines 19-29), and the step of carrying out the authentication process via a communications link with the common telecommunications system (Ohashi Col. 12 Lines 30-36), the authentication process being carried out by authenticating means incorporated in the telecommunications system and involving the use of the predetermined authentication information stored by the selected one authentication storage means (Ohashi Col. 12 Lines 30-36), the predetermined authentication information stored by each authentication storage means corresponding to information which is used to authenticate that user's telecommunications terminal in relation to the telecommunications system (Ohashi Col. 12 Lines 30-36) but the authentication process for authenticating the transaction by that user with the data processing apparatus not requiring use of that user's telecommunications terminal nor requiring the telecommunications terminal to be actually authenticated by that information in relation to the telecommunications systems (Ohashi Col. 5 Paragraph 2).

Regarding claim 13, Ohashi disclosed data processing apparatus in combination with a selected one of a plurality of authentication storage means which are respective to users and are each for storing predetermined authentication information relating to the carrying out of an authentication process for authenticating a subsequent transaction by the users with the data processing apparatus (Ohashi Col. 12 Lines 1-29), the authentication storage means all being registerable with a common telecommunications system for which the users have respective telecommunications terminals (Ohashi Col. 12 Lines 19-29), the authentication storage means when operatively associated with the data processing apparatus being operative to carry out the authentication process via a communications link with that system (Ohashi Col. 12 Lines 30-36), the authentication process being carried out by authenticating means incorporated in the system and involving the use of the predetermined information stored by the selected one authentication storage means (Ohashi Col. 12 Lines 30-36), the predetermined authentication information stored by each authentication storage means corresponding to information which is used to authenticate that user's telecommunications terminal in relation to the telecommunications system (Ohashi Col. 12 Lines 30-36) but the authentication process for authenticating the transaction by that user with the data processing apparatus not requiring that use of user's telecommunications terminal nor requiring the telecommunications terminal to be actually authenticated by that information in relation to the telecommunications system (Ohashi Col. 5 Paragraph 2).

Regarding claim 22, Ohashi disclosed a data carrier (Card Reader) carrying data for use in and by a data processing apparatus after an authentication process involving the use of the data processing apparatus and separate authenticating means (Ohashi Col. 12 Lines 1-36), the data

1 carrier also incorporating authentication storage means (Smart Card) storing predetermined
2 authentication information respective to a user (Ohashi Col. 12 Lines 19-29), the authentication
3 storage means being registered with a telecommunications system which includes the
4 authenticating means and for which the user has a telecommunications terminal (Ohashi Col. 12
5 Lines 19-29), the authentication storage means being responsive to an input message for deriving
6 a response dependent on the input message and on the authentication information for enabling
7 the authenticating means to carry out the authentication process via a communication link with
8 the authenticating means in the said system whereby to authenticate a subsequent transaction by
9 the user with the data processing apparatus and which involves use of the data carried by the data
10 carrier (Ohashi Col. 12 Lines 1-36), the predetermined authentication information stored by the
11 authentication storage means corresponding to information which is used to authenticate the user
12 registered with the telecommunications system in relation to use of that user's
13 telecommunications terminal in the telecommunications system (Ohashi Col. 12 Lines 30-36),
14 but the authentication process for authenticating the transaction by that user with the data
15 processing apparatus not requiring use of the user's telecommunications terminal nor requiring
16 the telecommunications terminal to be actually authenticated by that information in relation to
17 the telecommunications system (Ohashi Col. 5 Paragraph 2).

18 Regarding claim 2, Ohashi disclosed that the authentication storage means is associated
19 with the data processing apparatus by being associated with data or software for use by that data
20 processing apparatus (Ohashi Col. 5 Paragraphs 2-3).

21 Regarding claim 3, Ohashi disclosed that the authentication storage means is incorporated
22 on a data carrier for the data or software (Ohashi Col. 5 Lines 65-67).

Regarding claims 4, and 14, Ohashi disclosed that the authentication storage means includes processing means (Ohashi Col. 11 Lines 18-24).

Regarding claims 5, 15, and 23, Ohashi disclosed that each user is authenticated in the telecommunications system by means of the use of a smart card or subscriber identity module, and in which the authentication storage means respective to that user corresponds to or simulates the smart card for that user (Ohashi Col. 12 Lines 1-36).

Regarding claims 6, and 16, Ohashi disclosed that the authentication process involves the sending of a message and the generation of a response dependent on the message and the predetermined information (Ohashi Col. 12 Line 55 – Col. 13 Line 10).

Regarding claim 9, Ohashi disclosed that the data processing apparatus is a personal computer (Ohashi Col. 5 Paragraph 2).

Regarding claims 11, 20, and 26, Ohashi disclosed that the authentication storage means is one of a smart card and SIM that is operable to authenticate the user's telecommunications terminal for use in the system (Ohashi Col. 12 Lines 1-36).

Regarding claims 12 and 21, Ohashi disclosed that the authentication storage means is provided with a carrier coupleable to the data processing apparatus (Ohashi Col. 5 Paragraph 2).

Regarding claim 24, Ohashi disclosed that the data carried by the data carrier includes software (Ohashi Col. 4 Lines 64-66).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter

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1 *sought to be patented and the prior art are such that the subject matter as a whole would have*
2 *been obvious at the time the invention was made to a person having ordinary skill in the art to*
3 *which said subject matter pertains. Patentability shall not be negated by the manner in which*
4 *the invention was made.*

5 Claims 7-8, 10, 17-19, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over
6 Ohashi.

7 Regarding claims 7-8, and 17-18, while Ohashi disclosed providing a network service,
8 Ohashi fails to disclose the system levying a charge for the service transaction. However, it was
9 well known in the art of service providing to levy charges for providing the service. As such, it
10 would have been obvious to the ordinary person skilled in the art at the time of invention to have
11 had the system levy a charge for the service. This would have been obvious because the ordinary
12 person skilled in the art would have been motivated to provide the service provider with
13 compensation for the service.

14 Regarding claims 10, 19, and 25, while Ohashi disclosed the smart card communicating
15 with a smart card reader, Ohashi failed to disclose the communication being wireless. However,
16 it was well known at the time of invention for smart cards to communicate wirelessly. As such,
17 it would have been obvious to the ordinary person skilled in the art at the time of invention to
18 have provided the communications wirelessly. This would have been obvious because the
19 ordinary person skilled in the art would have been motivated to increase the ease of use for the
20 user.

21 **Conclusion**

22
23 Claims 1-26 have been rejected.

1 The prior art made of record and not relied upon is considered pertinent to applicant's
2 disclosure.

3 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
4 policy as set forth in 37 CFR 1.136(a).

5 A shortened statutory period for reply to this final action is set to expire **THREE**
6 **MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**
7 **MONTHS** of the mailing date of this final action and the advisory action is not mailed until after
8 the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period
9 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
10 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
11 however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing
12 date of this final action.

13 Any inquiry concerning this communication or earlier communications from the
14 examiner should be directed to **MATTHEW T. HENNING** whose telephone number is
15 (571)272-3790. The examiner can normally be reached on M-F 8-4.

16 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
17 supervisor, William Korzuch can be reached on (571)272-7589. The fax phone number for the
18 organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew T Henning/
Examiner, Art Unit 2431
/Syed Zia/
Primary Examiner, Art Unit 2431